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Davis & Bujold
Fourth Floor
500 North Commercial Street
Manchester NH 03101-1151

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OFFICE OF PETITIONS

In re Application of :
Gregory Michael Orme :
Application No. 09/830,007 : DECISION ON PETITION
Filed: April 20, 2001 : PURSUANT TO
Attorney Docket Number: GRIHAB : 37 C.F.R. § 1.137(A)
P09AU :
Title: METHOD OF COMPRESSING :
DATA AND COMPRESSIBLE DEVICES :

This is a decision on the petition filed April 26, 2010, pursuant to 37 C.F.R. § 1.137(a), to revive the above-identified application.

This petition is **DISMISSED**.

BACKGROUND

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. § 1.113 in a timely manner to the final Office action mailed August 13, 2009, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 C.F.R. § 1.136(a) were obtained, and response was received. Accordingly, the above-identified application became abandoned on November 14, 2009. A notice of abandonment was mailed on March 31, 2010.

RELEVANT PORTIONS OF THE C.F.R. AND M.P.E.P.

37 C.F.R. § 1.33(a) sets forth, *in pertinent part*:

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Correspondence address and daytime telephone number. When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address (emphasis added).

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

MPEP § 402.06 sets forth, *in pertinent part*:

See 37 CFR 1.36(a) in MPEP § 402.05 for revocation. See 37 CFR 10.40 for information regarding permissive and mandatory withdrawal. When filing a request to withdraw as attorney or agent of record, the patent attorney or agent should briefly state the reason(s) for which he or she is withdrawing so that the Office can determine whether to grant the request. Note that disciplinary rule, 37 CFR 10.40(a) provides that a "practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client." Among several scenarios addressed in 37 CFR 10.40(c), subsections (iv) and (vi) permit withdrawal when the client fails to compensate the practitioner, or when "other conduct on the part of the client has rendered the representation unreasonably difficult." When preparing a request for withdrawal for such reasons, the practitioner should also be mindful of 37 CFR 10.57(b)(2), which prohibits the use of a confidence or secret of a client to the disadvantage of a client. Where withdrawal is predicated upon such reasons, the practitioner, rather than divulging confidential or secret information about the client,

should identify the reason(s) for requesting to withdraw as being based on "irreconcilable differences." An explanation of and the evidence supporting "irreconcilable differences" should be submitted as proprietary material in accordance with MPEP § 724.02 to ensure that the client's confidences are maintained.

In the event that a notice of withdrawal is filed by the attorney or agent of record, the file will be forwarded to the appropriate official for decision on the request. **The withdrawal is effective when approved** (emphasis included) rather than when received.

MPEP § 601.03 sets forth, *in pertinent part*:

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application pro se) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office (emphasis added) of the new correspondence address (including ZIP Code). The notification should also include his or her telephone number. A change of correspondence address may not be signed by an attorney or agent not of record (see MPEP § 405).

THE APPLICABLE STANDARD

Nonawareness of a PTO rule will not constitute unavoidable delay¹

The burden of showing the cause of the delay is on the person seeking to revive the application.²

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."³

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁴

¹ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel. See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.

² Id.

³ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

⁴ See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action.⁵

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. at (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."⁶

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."⁷

ANALYSIS

A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(1);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in 37

⁵ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

⁶ Haines v. Quigg, 673 F. Supp. 314, 316-17; 5 USPQ2d at 1131-32.

⁷ Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

Receipt of the petition fee is acknowledged, along with a statements of facts from the Applicant. As such, the second requirement of Rule 1.137(a) has been met. The fourth requirement of Rule 1.137(a) is not applicable, as a terminal disclaimer is not required.⁸

Regarding the first requirement or Rule 1.137(a), the requirement has not been satisfied because Petitioner did not submit the required reply to the Office action. The required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.⁹ In order for the application to be revived, petitioner must submit a reply which satisfies 37 C.F.R. §1.137(a)(1) (i.e., a Notice of Appeal (and fee required by law); an amendment that *prima facie* places the application in condition for allowance; a continuing application under 37 C.F.R. §1.53(b); a request for continuing examination under 37 C.F.R. §1.114, if applicable; or a 37 C.F.R. §1.129(a) submission, if applicable). The petition was not accompanied by any of these replies: instead, Petitioner has made reference to a continuation application that he intends to file on a future date.

The third requirement Rule 1.137(a) has not been satisfied, since it has not been established that the entire period of delay was unavoidable.

The Applicant has indicated that he did not receive the final Office action, due to the fact that it was not mailed to his address. Instead, it was mailed to the address of his "old attorney Davis and Bujold," despite the fact that his attorneys submitted a request to withdraw as his attorneys.

Pursuant to 37 C.F.R. § 1.33(a), the Office will direct all notices relating to an application to the correspondence address. The transmittal sheet that was submitted on filing does not contain a correspondence address, and the transmittal letter which was filed concurrently therewith directs all correspondence to be directed to "Davis & Bujold, P.L.L.C., Fourth Floor, 500 North Commercial Street, Manchester, NH, 03101-1151." Therefore, pursuant to the portion of section 403 of the MPEP reproduced above; the Office properly directed all correspondence to this address.

⁸ See Rule 1.137(d).

⁹ See MPEP § 711.03(c).

On June 15, 2007, one of the three attorneys of record submitted a "Request for Withdrawal as Attorney or Agent and Change of Correspondence Address," requesting to withdraw as attorneys of record and to have the correspondence address changed to that of the inventor. The request was dismissed via the mailing of a decision on June 5, 2008.

As set forth in MPEP § 402.06, the "withdrawal is effective when approved rather than when received." As such, the request to withdraw as attorney of record is not effective as of the date on which the request was received in the Office, but rather the date on which the request is approved. Since the request was not approved, Office records were not updated to either reflect the change in power of attorney or the correspondence address.

It follows that the final Office action, subsequently mailed on August 13, 2009, was mailed to the proper address.

The electronic record has been reviewed, and it does not appear that Applicant submitted a revocation of power of attorney. Moreover, it does not appear that his attorneys submitted a change of address request other than the request made in conjunction with the request to withdraw as attorney of record.

Petitioner will note that the procedure set forth in Section 711.03(c)(I)(A) of the MPEP is inapplicable to the current set of facts, as the final Office action was properly mailed to the official correspondence address of record.

CONCLUSION

The present set of facts might result in a finding of unintentional delay, but it does not rise to the level of unavoidable.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.137(a)".

This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail¹⁰, hand-delivery¹¹, or facsimile¹².

¹⁰ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web¹³.

If responding by mail, Applicant is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Alternatively, Applicant may also file a petition pursuant to 37 C.F.R. § 1.137(b), which carries with it a much lower standard. Unless Applicant believes that he can successfully establish that the entire period of delay was unavoidable, he may wish to file pursuant to the unintentional standard. Applicant may download information about this petition here:

http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03c.htm#sect711.03c

Applicant will note that a third option is to concurrently file both a renewed petition pursuant to Rule 1.137(a) and a petition pursuant to Rule 1.137(b). If the former petition is granted, the fee that is associated with the filing of the latter petition will be refunded to Applicant.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.

11 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

12 (571) 273-8300- please note this is a central facsimile number.

13 <https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

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Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225¹⁴.

/Paul Shanowski/
Paul Shanowski
Senior Attorney
Office of Petitions

cc: Gregory Michael Orme
310 Oakwood Cove
LaVergne, TN 37086-4130

¹⁴ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).